

REMARKS

Claims 10 to 28 are currently pending in the present application.

In view of the following remarks, it is respectfully submitted that the pending claims are allowable, and reconsideration is respectfully requested.

Claims 10 to 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application No. 2004/0153243 A1 (the "Shimazaki" reference).

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

The Shimazaki reference was only filed on December 10, 2003 and issued on August 5, 2004, and is therefore not prior art even under Section 102(e) (let alone 102(b)) as asserted), since the present application claims priority to its German priority patent application of DE 103 31 235.8, which was filed in Germany on July 10, 2003. A certification of the English translation is accompanying this response. It is therefore respectfully requested that the Section 102 rejections be withdrawn.

Accordingly, claim 10 is allowable for these reasons alone, as are its dependent claims 11 to 28.

Claim 14, 21, 23, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as unpatentable over the combination of the “Shimazaki” reference in view of U.S. Patent No. 6,919,917 (the “Janssen” reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 14, 21, 23, 24, 26, and 27 ultimately depend from claim 10, and are therefore allowable for essentially the same reasons as claim 10, since the secondary reference does not cure -- and is not asserted to cure -- the critical deficiencies of the primary reference -- which is not prior art as to the present application.

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the “Shimazaki” reference in view of U.S. Patent no. 6,336,593 (the “Luckscheiter” reference).

Claim 17 depends from claim 10, and is therefore allowable for essentially the same reasons as claim 10, since the secondary reference does not cure -- and is not asserted to cure -- the critical deficiencies of the primary reference-- which is not prior art as to the present application.

Claims 22 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the "Shimazaki" reference in view of the "Janssen" reference and the "Luckscheiter" reference.

Claims 22 and 25 ultimately depend from claim 10, and are therefore allowable for essentially the same reasons as claim 10, as presented, since the secondary references do not cure -- and are not asserted to cure -- the critical deficiencies of the primary reference-- which is not prior art as to the present application.

Accordingly, claims 10 to 28 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of claims 10 to 28 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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